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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,589	04/29/2005	Jurgen Nick	LP-2000	9923
217 7590 05/20/2008 FISHER, CHRISTEN & SABOL 1725 K STREET, N.W. SUITE 1108 WASHINGTON, DC 20006				
EXAMINER HEINCE, LIAM J				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
05/20/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/516,589

Applicant(s)

NICK ET AL.

Examiner

Liam J. Heincer

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 13-25, 35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) 13-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 20-25, 35 and 36 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date. _____
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Claims 13-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 20, 2008.

Applicant's election of Group I, claims 1-7, 20-25, 35, and 36 in the reply filed on March 20, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Objections

Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 3 substantially repeats the limitation presented in claim 2 from which it depends.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Considering Claim 36: Claim 36 contains the trademark/trade names Solvent Yellow and Marcrolex®. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe specific dyes and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

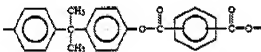
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-6, 20-23, 25, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takayama et al. (JP 60219899) in view of Kohn (US Pat. 4,746,472). Considering Claims 1-4, 6, 20, 21, 25, and 35: Takayama et al. teaches a diaphragm for a speaker comprising comprising a polyarylate resin film (JPO Abstract).

Takayama et al. does not teach the polyarylate resin as having the claimed structure. However, Kohn teaches a thin film polyarylate (5:13-21) with the formula



(3:10-15). Takayama et al. and Kohn are

combinable as they are concerned with the same field of endeavor, namely thin film polyarylate films. It would have been obvious to a person having ordinary skill in the art at the time of invention to have used the resin of Kohn in the diaphragm of Takayama et al., and the motivation to do so would have been, as Kohn suggests, these resins are the most common and are commercially available (3:9-19).

Takayama et al. does not teach the film as being cast. However, Kohn teaches casting a thin polyarylate film (4:51-63). It would have been obvious to a person having

Art Unit: 1796

ordinary skill in the art at the time of invention to have used the casting method of Kohn to form the film of Takayama et al., and the motivation to do so would have been, as Kohn suggests, to form a film with few imperfections (4:64-5:5).

Considering Claim 5, 22, and 23: Takayama et al. teaches the film thickness as being less than 100 μm (JPO Abstract).

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takayama et al. (JP 60219899) in view of Kohn (US Pat. 4,746,472) as applied to claim 1 above, and further in view of van der Scheer et al. (US Pat. 4,556,530).

Considering Claim 36: Takayama et al. and Kohn collectively teach the diaphragm of claim 1 as shown above.

Takayama et al. does not teach the film as including an additive. However, van der Scheer et al. teaches a thin film made with a nonionic polyol surface active agent (3:26-43). Takayama et al. and van der Scheer et al. are combinable as they are concerned with the same field of endeavor, namely thin polymeric films. It would have been obvious to a person having ordinary skill in the art at the time of invention to have used the surface active agent of van der Scheer et al. in the film of Takayama et al., and the motivation to do so would have been, as van der Scheer et al. suggests, to provide a thin film with high density (2:60-3:6).

Claims 7 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takayama et al. (JP 60219899) in view of Kohn (US Pat. 4,746,472) as applied to claims 5 and 6 above, and further in view of Ugaji et al. (US Pat. 4,281,223). Considering Claims 7 and 24: Takayama et al. and Kohn collectively teach the diaphragm of claims 5 and 6 as shown above.

Takayama et al. does not teach the diaphragm being used in one of the claimed devices. However, Ugaji et al. teaches using a diaphragm made from a resin film (2:63-3:7) in a loudspeaker or microphone (3:40-51). Takayama et al. and Ugaji et al. are combinable as they are concerned with the same field of endeavor, namely acoustic devices made from resin film diaphragms. It would have been obvious to a person having ordinary skill in the art at the time of invention to have used the diaphragm of Takayama et al. in a microphone or loudspeaker as in Ugaji et al., and the motivation to do so would have been, as Ugaji et al. suggests, to provide a electro-acoustic transducer (1:8-21).

Double Patenting

Applicant is advised that should claim 2 be found allowable, claim 3 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liam J. Heincer whose telephone number is 571-270-3297. The examiner can normally be reached on Monday thru Friday 7:30 to 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MARK EASHOO/
Supervisory Patent Examiner, Art Unit 1796
19-May-08

LJH
May 13, 2008